

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicants: Naoki NISHIURA <i>et al.</i> | Atty. Docket No.: VX062753 PCT |
| Application No.: 10/591,326 | Art Unit: 1766 |
| Filed: August 31, 2006 | Examiner: Shane Fang |
| Title: ENDLESS TUBULAR POLYIMIDE FILM | Confirmation No.: 9434 |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Date: June 6, 2011

FILED ELECTRONICALLY

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In view of the Final Office Action mailed on January 4, 2011 and the Notice of Appeal filed concurrently herewith, please consider the following remarks.¹ Applicants filed a Response After Final on March 31, 2011, which included a Rule 132 declaration of Naoki Nishiura (“Nishiura declaration”) that was entered by the Examiner.²

Claims 1 – 8, 10, and 12 – 32 are pending in the application. Claims 1 – 6 and 17 – 32 were withdrawn from consideration by the Examiner as being directed to a non-elected invention. Claims 7, 8, 10, and 12 – 16 were examined and rejected in the Final Office Action.

Arguments Against the Rejection under 35 U.S.C. § 103

The Examiner maintained the rejection of claims 7, 8, 10, and 12 – 16 under 35 U.S.C. § 103(a) as being unpatentable over Kanetake³ in view of Economy⁴ in further view of Hasegawa⁵

¹ The Final Office Action set forth a three-month period for response, and a petition for a two-month extension of time is attached hereto, making the Notice of Appeal submitted herewith and this Pre-Appeal Brief Request for Review due on or before June 4, 2011. Since June 4, 2011 was a Saturday, the Notice of Appeal and Pre-Appeal Brief Request for Review can be filed on the next business day, namely, Monday, June 6, 2011. See 37 C.F.R. § 1.7

² In a first Advisory Action mailed April 13, 2011, the Examiner refused to enter the Nishiura declaration. In a telephone interview with Examiner Shane Fang conducted May 3, 2011, he stated that he should have entered the declaration. In a second Advisory Action mailed May 9, 2011, the Examiner entered the Nishiura declaration.

³ US 6,303,054

⁴ US 4,467,000

⁵ *Structure and Properties of Novel Asymmetric Biphenyl Type Polyimides* in *Macromolecules*, Vol. 32, No. 2, pp. 387 – 396, 1999.

and evidenced by Wilson⁶. Applicants respectfully submit that the Examiner has not provided a sufficient reason for one of ordinary skill in the art to combine the teachings of Kanetake, Economy, and/or Hasegawa (Wilson). In addition, the Examiner has not properly considered the evidence in the Nishiura declaration, which explains why one of ordinary skill in the art would not combine the teachings of Kanetake, Economy, and/or Hasegawa, and which explains why such teachings teach away from their combination.

In the Advisory Actions, the Examiner stated that the Nishiura declaration shows no evidence of comparing with closest prior arts cited to rebut the previous 103 rejection and that the whole document merely contains arguments that were previously submitted. The Examiner concluded, “Thus, this 1.132 [declaration] is found insufficient.”

These factual findings of the Examiner are in error. Applicants respectfully submit that the Examiner must consider the Nishiura declaration as evidence of factual findings demonstrating the nonobviousness of the presently claimed invention, and when the Nishiura declaration is so properly considered, there is no other conclusion but that the presently claimed invention is nonobvious.

Assuming that the Examiner has made a *prima facie* case of obviousness (which Applicants do not admit here), Applicants can reply by explaining why and/or providing evidence showing that the claimed subject matter would have been nonobvious. This is basic patent law. See, for example, M.P.E.P. §§ 706.07(a), 2141. Applicants’ evidence can include rebuttal evidence, such as a Rule 132 declaration, which is not limited to comparative evidence, but can include opinion evidence that the art teaches away from the invention, etc. *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992), *In re Sullivan*, 498 F.3d 1345 (Fed. Cir. 2007). See also, M.P.E.P. § 2145. The *Sullivan* case was decided after and considered by the U.S. Supreme Court precedent of *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

In the *Sullivan* case, the Court of Appeals for the Federal Circuit (CAFC) reversed the Board of Patent Appeals and Interferences of the USPTO, because the Board did not consider an expert declaration submitted to show that the prior art taught away from the claimed invention. In the *Sullivan* case, the Board and the Examiner had dismissed the declaration as allegedly not being directed to an issue of patentability. As stated by the CAFC in *Sullivan*, nonobviousness can be shown when a person of ordinary skill in the art would not have reasonably predicted the claimed

⁶ Polyimide, Blackie & Son Ltd., 1990, pp. 1 – 2, scheme 1.2

invention based on the prior art, and the resulting invention would not have been expected. All evidence must be considered when properly presented. See also, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

The Examiner's comments that the Nishiura declaration "shows no evidence of comparing with closest prior arts cited to rebut the previous 103 rejection" and that the "whole document merely contains arguments that are repeated in submitted Applicant Argument/Remarks" is completely off point and contrary to the basic principles of patent law and patent examination, as discussed above. Based on the above case law and M.P.E.P. sections, it cannot be refuted that the factual findings in the Nishiura declaration must be considered by the Examiner. The factual findings in the Nishiura declaration establish that a person of ordinary skill in the art would not have reasonably predicted the presently claimed invention based on the cited prior art, and that the presently claimed invention would not have been expected by one of ordinary skill in the art. Therefore, the presently claimed invention cannot be obvious over the cited teachings.

In the Advisory Actions, the Examiner took the position that Kanetake pertains to a polyamic acid composition for carbon filled polyimide films, Hasegawa and Wilson pertain to polyimide compositions for making polyimide films, and Economy teaches producing a polyimide film on a substrate. For this reason, the Examiner asserted that Economy and Hasegawa teach motivations to be combined with Kanetake. In other words, the Examiner's reason for combining these teachings is that they all pertain to polyamic acid composition and polyimide films.

Applicants respectfully submit the fact that the teachings of Kanetake, Economy, and/or Hasegawa allegedly pertain to polyamic acid compositions and polyimide films cannot be a sufficient reason or motivation to combine their teachings. While this factual finding of the Examiner could possibly establish that the teachings of the prior art are related art, one of ordinary skill in the art needs more reason than this to take an isolated part of one polyamic acid composition or polyimide film and substitute or add it to another polyamic acid composition or polyimide film (together with any reasonable expectation of success based on some meaningful objective). Without a meaningful reason, one of ordinary skill in the art would not make the combinations and substitutions proffered by the Examiner. There is simply no meaningful reason to do this.

The Nishiura declaration sets forth factual findings by an expert in the art. Initially, the Nishiura declaration provides a factual foundation describing the material of the presently claimed invention and the materials of the cited teachings. In addition, the Nishiura declaration sets forth

factual findings that the material (“Material 1”) of the presently claimed invention is different from the material of Economy (“Material 2”), and that both of these materials are different from the materials of Hasegawa, Kanetake, and Wilson (“Material 3”).

Perhaps most importantly, the Nishiura declaration sets forth the following factual findings:

- The objectives of Kanetake and Economy are different and *require different essential components* – a *specific* carbon black added in a *specific amount* for Kanetake and a composition containing *both* an amino-terminated amic acid oligomer and a tetracarboxylic acid diester of a specific alcohol *as essential components* for Economy. The combination proffered by the Examiner as suggesting the presently claimed invention eliminates these essential components from the teachings of Kanetake and Economy, which therefore both teach away from such a combination.
- Since the teachings of Kanetake and Economy are directed to different types of compositions having different properties (technical fields of invention that are clearly different), there is no reason or motivation for one of ordinary skill in the art to substitute an isolated portion from one of these teachings into the other of the teachings or vice a versa.
- The combination of teachings proffered by the Examiner eliminates the tetracarboxylic acid diester of a specific alcohol that is a constituent of the invention of Economy, and thus the combination proposed by the Examiner destroys the teachings of at least one cited reference.
- Ultimately, there is simply no reason or motivation to combine Hasegawa and/or Wilson with Kanetake and Economy and arrive at the presently claimed invention.
- The presently claimed invention is directed to a seamless tubular polyimide film having a tough polyimide film with a high yield stress and high tensile strength, which can be formed by reacting an aromatic diamine with an aromatic tetracarboxylic acid component mixture comprising 15 to 55 mol% of an asymmetric aromatic tetracarboxylic acid component and 85 to 45 mol% of a symmetric aromatic tetracarboxylic acid component. No person skilled in the art would have conceived of this structure and the resulting properties from the teachings of Kanetake, Economy, Hasegawa, and Wilson either alone or combined.

If the Examiner is not convinced that the factual findings in the Nishiura declaration prove the patentability of the presently claimed invention, the Examiner must explain unequivocally why the factual findings in the Nishiura declaration are not persuasive. For example, the Examiner must set forth explicit reasons why the factual findings in the Nishiura declaration are incorrect or do not support the legal conclusion of nonobviousness. As stated by the Supreme Court in *KSR*, the analysis supporting a rejection under 35 U.S.C. §103 should be made explicit. Otherwise, the Examiner should allow claims 7, 8, 10, and 12 – 16 and consider rejoinder of such allowed claims with the withdrawn claims.

Arguments Against the Double Patenting Rejection

Since Applicants' claims are free of prior art for reasons set forth above, Applicants again request that the Examiner withdraw the double patenting rejection in this application. In the Advisory Actions, the Examiner stated that it is possible that a double patenting rejection in the later application may not be appropriate and that it is not the Office's issue/problem that the other application was filed "much earlier" than the application. Applicants respectfully submit that the Examiner's first position is not tenable. Here, double patenting means two applications are claiming the same invention. If a double patenting rejection cannot be made in the later application, then it logically follows that it cannot be made in the earlier filed application or vice a versa. Secondly, Applicants never stated that the filing date of this or the other application was the issue or problem of the Office. The respective filing dates are simply facts, and based on these facts and the fact that the present application is now otherwise in condition for allowance, the double patenting rejection should be withdrawn.

Conclusion

For at least the reasons given above, the Examiner's prior art and double patenting rejections of Applicants' pending claims are improper and should be withdrawn. Therefore, Applicant respectfully requests that the Examiner's final rejection be withdrawn and the application allowed.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,
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